

REMARKS

Claims 1, 4-23, and 26-36 are pending in the application. In section 1 of the office action, the Examiner rejected claims 1, 4-11, 21-23, 26, 28, and 29-33 under 35 USC 103(a) as being unpatentable over US patent 5,884,032 to Bateman et al. (herein after Bateman) in view of US patent 4,052,570 to Sutton (herein after Sutton) in further view of US patent application 2001/0040887 to Shtivelman et al. (herein after Shtivelman).

In response, Applicant submits the Declaration of Malcom Strandberg as evidence that Bateman, Sutton, and Shtivelman, whether considered separately or all together, fail to teach or suggest the invention to one of ordinary skill in the art because they contain absolutely no recognition of the problem solved by the present invention and provide no motivation to one of ordinary skill in the art to combine or modify the references in such a way as to arrive at the claimed invention. As set forth in the accompanying Declaration of Malcom Strandberg, each of the foregoing references addresses problem(s) completely different from the problem(s) solved by the present invention. The Office Action applies hindsight to combine the references in manner as to arguable disclose Applicant's invention.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect taught is used against the teacher." (*Id.* At 1369, 55 USPQ2d at 1316)

In particular, the problem solved by the present invention is how best to connect a telephone call to an inquiring party using a telephone line when the inquiring party has prompted the call by accessing a computer network using said telephone line. (See Strandberg Declaration at para. 5). The present invention is based upon the recognition that the best time to respond to the inquiring party's request is immediately, and further that the inquiring party's telephone line will be busy until he has ended his modem's connection to the network over the telephone line. Accordingly, the systems and methods of the present invention immediately redial the inquiring party's telephone number when a busy signal is detected so as to connect the call as soon as

possible after the inquiring party has ended his modem's connection to the network over the telephone line. (Id. at para. 5).

Bateman concerns a system for allowing a call center agent and a customer to simultaneously talk on the telephone and view information available on a computer network over a telephone line and separate second network connection. (Id. at para. 6). Because the agent in the Bateman system calls the customer back on a separate line than the line that the user uses to access information on the computer network, Bateman suggests nothing about how to best call back an inquiring party on the same line that the inquiring party used to access information on the computer network. (Id.).

Sutton concerns a device that detects a busy signal, disconnects the call, waits a predetermined period of time, and redials the number. But nothing in Sutton has anything to do with identifying the best time to contact an inquiring party who has requested a callback by accessing a computer network over a telephone line. Sutton is directed to a telephone set that automatically redials a telephone number after a busy signal has been received once a user has previously dialed the telephone

number. Sutton does not teach or suggest using the device to contact an inquiring party who has requested a callback by accessing a computer network over a telephone line. Even if one were to apply to device of Sutton to a call center, which Applicant does not concede, every busy call placed by a call center would result in inefficient use of call center resources. Applicant's invention recognizes that placing continuous call back to parties who have requested a callback by accessing a computer network over a telephone line provides efficient use of resources and while meeting customer demands.

Shtivelman et al. concerns a customer device including a telephone and computer connected to the same telephone line. But nothing in Shtivelman has anything to do with identifying the best time to contact an inquiring party who has requested a callback by accessing a computer network over a telephone line. Thus, Shtivelman contains no recognition of the problem addressed by the present, let alone its solution.

Thus, it is clear that no combination of Bateman, Sutton, and Shtivelman teaches or suggests the present invention to one of ordinary skill in the art. Accordingly, Applicant submits that the rejections of claims 1, 4-11, 21-23, 26, 28, and 29-33 under

35 USC 103(a) as being unpatentable over Bateman, Sutton, and Shtivelman are improper and should be withdrawn.

In section 2, claims 12-20, 27, and 34-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 to Bateman et al. (hereinafter Bateman) in view of U.S. Patent No. 4,052,570 to Sutton (herein after Sutton) and further in view of U.S. Patent No. 5,214,688 to Szlam et al. (herein after Szlam). Applicant respectfully traverses this rejection.

In addition to the arguments discussed above, Applicant additionally submits that the combination of Bateman et al. and Szlam et al. is improper because there is no motivation to combine the references. The Examiner has explicitly acknowledged that Bateman et al. make no reference whatsoever to a predictive dialer, but argues that it would have been obvious for one of ordinary skill in the art to combine the teachings of Bateman et al. with those of Szlam et al. Nevertheless, the Examiner simply states that there is motivation to combine the references because both deal, generally, with call centers.

Applicant submits that it is improper for the Examiner to state that there is motivation to combine Bateman et al. and

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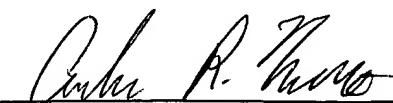
Sutton et al. simply because the two references deal, generally, with call centers. While, there may be some overlap between the users of the technology of Bateman et al. and Szlam et al., the technology and algorithms used in predictive dialing applications have no connection to the technology of Bateman et al. and the present invention which involve primarily networking and internetworking. The fact that the lengthy specifications of both Bateman et al. and Szlam et al. make no reference to the other's technology or applications is indicative of the disparateness of the subject matter.

In view of the foregoing, Applicant believes that all of the pending claims are in condition for allowance and requests early and favorable action on the merits. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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